

Serial No. 10/653,027

Dkt.: P-21544.02

Filing Date: August 28, 2003

Title: TISSUE CONNECTOR APPARATUS AND METHODS



REMARKS

In response to the PTO's request for disclosure of all co-pending applications and related patents, applicant submits two tables listing issued patents (TABLE 1) and pending applications (TABLE 2). The table of pending applications also provides corresponding claim numbers which are believed by applicants to be the most currently pending claim sets. Applicant has also provided printed copies of each of these claim sets for the pending applications, however, printed copies of the pending claims for applications 10/814,865 and 11/521,152 have not been provided since the pending claims for these applications are currently identical to the claims as published in the published applications.

Applicant reserves the right to reassert canceled claims, file divisional or continuation applications and makes no representation that any application will not subsequently be amended to protect disclosed, but previously unclaimed subject matter.

Applicants respectfully submit that the enclosed response is fully responsive to the proper scope of a Requirement For Information. According to MPEP 704.11, "requirements under 37 C.F.R. 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant." The Request for Information cites MPEP 704.11(a) subsection (G) as authority to require applicant to undergo the rigorous and unduly burdensome task of comparing all inventions and to determine what applicant believes is commonality among the claims. Subsection (G) does not support such a broad and sweeping demand for information. Instead, subsection (G) provides an example of what may be *reasonably* required in a Requirement for Information and states:

Identification of pending or abandoned applications filed by at least one of the inventors or assigned to the same assignee as the current application that disclose similar subject matter that are not otherwise identified in the current application. (emphasis added)

To require applicant to go beyond identification of such applications or patents would effectively be to require applicant to formulate opinions and as such is an improper request. In addition, MPEP 704.14 states, "A requirement for information under 37 C.F.R. 1.105 should be

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narrowly specified and limited in scope...A requirement for information is only warranted where the benefit from the information exceeds the burden in obtaining information.” To require applicant to engage in comparison of and identification of claims believed to present double patenting issues is a requirement which exceeds the scope of the duties that can be properly imposed on an applicant for patent.

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CONCLUSION

Applicant respectfully submits the foregoing information and maintains that the pending claims are in condition for allowance therefore applicant requests the issuance of a formal Notice of Allowance at an early date. If a telephone interview would advance prosecution of the application, the Examiner is invited to telephone the undersigned at the number provided below.

A request for a three (3) month extension of time under 37 C.F.R. 1.136(a) has been filed with this response. Please charge to Deposit Account No.13-2546 the fee of \$1020.00 which is required for the three-month extension of time.

An information disclosure statement has been filed with this response. According to MPEP 704.14(d) this reply, since it is submitted within the period for reply including any extensions of time, is not subject to the fee and/or certification requirements of 37 C.F.R. 1.97 and 1.98. However, if this is in error, please charge any required fees to Deposit Account No.13-2546.

Please also charge any other required fees or credit any overpayment to Deposit Account No. 13-2546.

Respectfully submitted,

Date: May 29 2007

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